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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,308	07/27/2001	Linda Marie Sweeting	SWEETING-PA-1	9575

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EXAMINER

CELSA, BENNETT M

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 08/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.
09/917,308

Applicant(s)
Sweeting, L.M.

Examiner
Bennett Celsa

Art Unit
1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 1-11 are currently pending.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 10, drawn to a 1st tribolumescent compound, classified in class 548, subclass 262.1.
 - II. Claims 11, drawn to a 2nd tribolumescent compound classified in class 548, subclass 143.
 - III. Claim 1, drawn to a 1st tribolumescent compound library , classified in class 435, subclass 6+
 - IV. Claim 2, drawn to a 2nd tribolumescent compound library , classified in class 435, subclass 6+.
 - V. Claims 3-9, drawn to a method of synthesizing and screening a combinatorial library 435 , subclass 4.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are drawn to independent and/or patentably distinct compounds due to differences in chemical formula, capability of separate manufacture and/or use and possessing different biological/chemical physical properties. Additionally, these separate inventions encompass compounds which require different and separately burdensome manual and/or

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computer structure, name, classification and bibliographic searches in patent and literature databases.

4. Inventions III and IV are drawn to independent and/or patentably distinct compound libraries due to the individual library members containing differences in chemical formula, capability of separate manufacture and/or use and possessing different biological/chemical physical properties. Additionally, these separate library inventions encompass individual library compound members which require different and separately burdensome manual and/or computer structure, name and bibliographic searches in patent and literature databases.

5. Inventions (I and II) as compared to Inventions (III and IV) are drawn to independent and/or patentably distinct inventions since the libraries may contain compound members which possess differences in chemical formula, capability of separate manufacture and/or use, possessing different biological/chemical physical properties. Where the Invention I and II compounds are members of the combinatorial libraries of III and IV, respectively the compound and library Inventions are nevertheless independent and/or patentably distinct inventions since a reference to one compound would not be expected to anticipate and/or render obvious a combination of that compound with one or more different compounds; and additionally, the issues under 35 USC 112, first and second paragraphs are different for a compound verse a combinatorial invention as is the classification search. Further, in either instance above a compound search of Inventions I or II is different and separately burdensome from a library search of Inventions III or IV since the searches require different and separately burdensome

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manual and/or computer structure, name and bibliographic searches in patent and literature databases.

6. Inventions V and (I, II, III or IV) are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case (1) the process as claimed can be used to make other and materially different product or (2) the product as claimed can be made by another and materially different process. See e.g. specification pages 1-5 exemplifying alternative methods of syntheses and screening of and/or using triboluminescent compounds.

7. Because these inventions are distinct for the reasons given above and

a. have acquired a separate status in the art as shown by their different classification; and/or

b. difference in manual/computer classification, structure, name and bibliographic searches;

and/or

c. inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Election of Species (Groups I-IV)

8. This application contains claims directed to the following patentably distinct species of the claimed invention: tribolumescent compounds, libraries thereof and syntheses and use thereof. The tribolumescent compounds are independent and/or patentably due to differences in chemical formula, capability of separate manufacture and/or use and possessing different biological/chemical physical properties. Additionally, these separate compounds require different and separately burdensome manual and/or computer structure, name and bibliographic searches in patent and literature databases.

Applicant is required under 35 U.S.C. 121 to elect **a single disclosed tribolumescent species (e.g. a single compound)** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a properly generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)
August 15, 2003

BENNETT CELSA
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'Bennett Celsa', written over a horizontal line.